

REMARKS

Claims 1 through 31 are pending in this application.

Claim Rejections- 35 U.S.C. § 102(b)

The Patent Office rejected claim 25 under 35 U.S.C. § 102(b) as being anticipated by Atech Flash and their product "PRO II USB MULTI-SLOT CARD READER/WRITER" (hereinafter referred to as PRO II). Applicants respectfully traverse.

The Federal Circuit has stated that "anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W.L. Gore & Assocs. v. Garlock*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). If anticipation is based upon the inherent teaching of a prior art reference, the Examiner must provide a rationale or evidence tending to show inherency. As stated in *In re Robertson*, "to establish inherency the extrinsic evidence must make clear that the missing descriptive matter is *necessarily* present in the thing described in the reference, and that it would be recognized by persons of ordinary skill." (emphasis added) *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). Additionally, "[i]nherency...may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient." *In re Oelrich*, 666 F.2d 578,581, 212 USPQ 323, 326 (C.C.P.A. 1981) *citing* *Hansgirk v. Kemmer*, 102 F.2d 212, 214, 40 USPQ 665, 667 (C.C.P.A. 1939). Emphasis added.

Claim 25 as amended recites a "means for shielding electromagnetic interference." Amended claim 25 includes elements that have not been taught, disclosed or suggested by PRO II. For example, PRO II fails to teach, disclose or suggest a "means for shielding electromagnetic interference" as recited in claim 25 as amended. PRO II does not disclose a USB flash bay with means for shielding electromagnetic interference. Instead, PRO II fails to employ any method for shielding electromagnetic interference.

Accordingly, the rejection of claim 25 should be withdrawn and claim 25 should be allowed because PRO II fails to explicitly or implicitly teach, disclose, or suggest a

USB flash bay having a “means for shielding electromagnetic interference.” Claims 26-28 and claims 30-31 are believed to be allowable based on their dependence upon the allowable base claim.

Claim Rejections – 35 U.S.C. § 103(a)

The Examiner rejected claim 1 under 35 USC § 103(a) as being unpatentable over PRO II in view of Batta et al. (Batta)(U.S. Pat. No. 5,262,923A). The Examiner stated it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings to include a latching mechanism in order to secure the flash drive in a computer tower. Applicants respectfully traverse.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Ryoka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974). See also *In re Wilson*, 165 U.S.P.Q. 494 (C.C.P.A. 1970). Moreover, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all the claim limitations.” (emphasis added) (MPEP § 2143). If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. (emphasis added) *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). In addition, “a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” M.P.E.P. 2131.02, citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). Further, “[i]nherency. . . may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient.” *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (C.C.P.A. 1981) citing *Hansgird v. Kemmer*, 102 F.2d 212, 214, 40 USPQ 665, 667 (C.C.P.A. 1939). Emphasis added. Applicant respectfully submits that independent claims 1, 9, 17, and 25 include elements that are not disclosed,

taught or suggested by any of the references cited by the patent office, either alone or in combination.

PRO II discloses a multi-slot card reader/writer. Batta discloses a latching engagement that prevents a disc drive from moving out of a bay. There is no suggestion in either of the references that they be combined in the manner suggested by the Examiner. Absent such a suggestion, a person skilled in the art who was looking for a solution to the problem of using a flash card reader with an information handling system as exhibited by PRO II would hardly be disposed on any objective basis to consider a reference like Batta, which shows no recognition of the problem of using a flash card reader with an information handling system, let alone any structure that would avoid or solve it.

Moreover, the structure that would result from the Examiner's proposed combination does not meet the terms of amended claim 1. Claim 1 as amended recites a "housing configured to shield electromagnetic interference." By contrast, both PRO II and Batta fail to disclose a housing configured to shield electromagnetic interference. The combination that would result would still lack a housing configured to shield electromagnetic interference as required by claim 1. Therefore, claim 1 as amended is patentably distinct from the combination of PRO II and Batta. Thus, independent claim 1 is nonobvious under 35 U.S.C. § 103(a). A similar argument to those made above can be made for claims 9 and 17.

Claims 2-8 depend from allowable base claim 1, therefore, claims 2-8 are patentably distinguishable from PRO II and Batta.

Similar arguments to those made above can also be made for claims 10-16, 18-24, and 29.

The Examiner rejected claims 4, 12, 20, and 29 under 35 USC § 103(a) as being unpatentable over PRO II in view of Intel (Communications and Networking Riser Specification Revision 1.2). The Examiner stated that it would have been obvious to one of ordinary skill in the art at the time of the invention to combine PRO II and a motherboard riser as disclosed by Intel to connect a flash bay drive to the motherboard.

Claims 4, 12, 20, and 29 depend from allowable base claims 1, 9, 17, and 25, therefore, claims 4, 12, 20, and 29 are patently distinguishable from PRO II and Intel.

The Examiner rejected claims 5, 13, and 21 under 35 USC § 103(a) as being unpatentable over PRO II in view of what was commonly known in the art. The Examiner stated that it would have been obvious to one of ordinary skill in the art at the time of the invention to include at least four USB ports on the faceplate.

Claims 5, 13, and 21 depend from allowable base claims 1, 9, and 17, therefore, claims 5, 13, and 21 are patently distinguishable from PRO II and what was commonly known in the art.

The Examiner rejected claims 6, 14, and 22 under 35 U.S.C. § 103(a) for being unpatentable over PRO II in view of Li (U.S. Pat. No. 6,681,991B1). The Examiner stated that it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to combine the teachings to implement a dedicated flash slot for each memory type.

Claims 6, 14, and 22 depend from allowable base claims 1, 9, and 17, therefore, claims 6, 14, and 22 are patently distinguishable from PRO II and Li.

Based on the rationale above, Applicant contends that none of the references cited by the Patent Office against the present invention, either alone or in combination, teach, disclose, or suggest the above referenced elements as claimed in the claims of the present application, and therefore, the above-cited references do not preclude patentability of the present invention under 35 U.S.C. § 102(b) or 35 U.S.C. § 103(a). Applicant further contends that it would have not been obvious to one of ordinary skill in the art at the time of the present invention to combine or modify any of the above cited references to arrive at the present invention as claimed. As a result, a *prime facie* case of obviousness has not been established for independent claims 1, 9, and 17.

Applicant respectfully requests entry of the amendments, and removal of all the pending rejections under 35 U.S.C. §102(b) and 35 U.S.C. § 103(a) is respectfully requested. No new matter has been added by the amendments. Support for the amended claims may be found throughout the specification.

CONCLUSION

In light of the foregoing amendments and remarks, Applicants respectfully request a timely Notice of Allowance. Applicant would like to extend the possibility of a phone interview at the number listed below if the Examiner believes this would be helpful.

Respectfully submitted,

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